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Joseph M. Koenig JR.

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EXAMINER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/692,703
Filing Date: October 24, 2003
Appellant(s): KOENIG, JOSEPH M.

Jeffery N. Fairchild
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 04 December 2008 appealing from the Office action mailed 30 June 2008.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

2,386,900	KINGMAN	10-1945
2,553,254	HAYS	5-1951

5,429,545

MEYER

7-1995

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 5 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kingman, 2,386,900 in view of Meyer, 5,429,545. Kingman discloses the claimed invention, including a sanding block comprising an abrasive grit **20** bonded to a core **10**, the sanding block conforming, when viewed macroscopically before the sanding block becomes worn, substantially to a block having two expansive sides **11,12** and two adjacent sides **12,14**, wherein a given one of the expansive sides is abrasive, wherein the given one of the expansive sides has two opposite edges, at each of which one of the adjacent sides adjoins the given one of the expansive sides, wherein a given one of the opposite edges, when viewed macroscopically before the sanding block becomes worn, is a sharp edge **18**, and wherein the other one of the opposite edges, when viewed macroscopically before the sanding block becomes worn, is a curved edge **17**; the adjacent side adjoining the given one of the expansive sides at the sharp edge is also abrasive; and the other one of the expansive sides and the other one of the adjacent sides are also abrasive. Kingman does not disclose that the core is a flexible,

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compressible, polymeric foam, or, when viewed macroscopically before the sanding block becomes worn, the curved edge defines a radius not less than about 1/8 inch at any location on said curved edge. Meyer, in a similar hand held abrasive tool, teaches making the tool core from a flexible, compressible polyurethane (polymer) foam.

Because both Kingman and Meyer teach providing a core, and bonding abrasive grit to the core to form the tool, it would have been obvious to one skilled in the art to substitute one material for the other to achieve the predictable result of a hand held tool that conforms to the shape of the workpiece. Further, Kingman does not explicitly disclose that the curved edge defines a radius not less than about 1/8 inch at any location on the curved edge. Kingman does disclose that the edge is curved. It would have been an obvious matter of design choice to have made the curved edge of whatever size of curvature desired, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955). Here, Kingman teaches, column 4, lines 9-18, that the curved portions of the tool may be made to fit the curved portions of the work piece. It would have been obvious to one of ordinary skill to have provided Kingman with the claimed radius of curvature, dependent on the shape of the work piece being sanded. Note that Kingman discloses that all sides of the block may be abrasive, figures 3 and 4, which meets the limitations of claim 9.

Claims 3, 4, 6- 8 and 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kingman '900 in view of Meyer, 5,429,545 as applied to claim 1

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above, and further in view of Hayes, 2,553,254. Kingman as modified by Meyer does not disclose the sharp edge defined by an acute angle in the range from about 55 to 70 degrees. Hayes, in a similar abrasive tool, teaches providing a sanding block conforming, when viewed macroscopically before the sanding block becomes worn, substantially to a block having two expansive sides, top and bottom 3, and two adjacent sides, left and right, 2, wherein a given one of the expansive sides is abrasive, wherein the given one of the expansive sides has two opposite edges, at each of which one of the adjacent sides adjoins the given one of the expansive sides. Hayes does not explicitly disclose that the edges are sharp or curved, but does clearly show in the drawings that the angle between one of the expansive and adjacent surfaces is between from about 55 to 70 degrees. MPEP 2125 states: Drawings and pictures can anticipate claims if they clearly show the structure which is claimed. In re Mraz, 455 F.2d 1069, 173 USPQ 25 (CCPA 1972). Here, Hayes clearly discloses that the acute angle (measured from a vertical line extending from the edge) formed by the expansive and adjacent sides is between about 55 to 70 degrees. Kingman discloses that the adjacent sides adjoining the expansive sides are also abrasive, see figures 3 and 4.

Added: It would have been obvious to one of ordinary skill in the art to have provided Kingman with the range of degree for the sharp edge as taught by Hayes, to allow the tool to better conform to surfaces that form inner acute angles.

NOTE: The motivation statement was inadvertently omitted from this rejection in the previous Office action. If the Board considers that now including this statement makes

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a new grounds of rejection, the Board is requested to remand the appeal to the examiner for further action and clarification. See further remarks below.

(10) Response to Argument

Appellant argues that the rejection ignores the express teachings of Kingman and proposes a modification that is contrary to these teachings. The examiner disagrees. It is true that Kingman teaches the claimed shape of the tool, and that the tool disclosed by Kingman is a rigid block surrounded by a resilient layer that contains the abrasive. However, it is known in the art to increase the resiliency of such tools by providing an inner core that is also resilient, as taught by Meyer, which teaches a tool having a resilient core, a resilient abrasive layer, and a different shape.

MPEP 2143.01 states in part:

Obviousness can be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so. *In re Kahn*, 441 F.3d 977, 986, 78 USPQ2d 1329, 1335 (Fed. Cir. 2006).

and

In *In re Fulton*, 391 F.3d 1195, 73 USPQ2d 1141 (Fed. Cir. 2004), the claims of a utility patent application were directed to a shoe sole with increased traction having hexagonal projections in a “facing orientation.” 391 F.3d at 1196-97, 73 USPQ2d at 1142. The Board combined a design patent having hexagonal projections in a facing orientation with a utility patent having other limitations of the independent claim. 391 F.3d at 1199, 73 USPQ2d at 1144. Applicant argued that the combination was improper because (1) the prior art did not suggest having the hexagonal projections

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in a facing (as opposed to a "pointing") orientation was the "most desirable" configuration for the projections, and (2) the prior art "taught away" by showing desirability of the "pointing orientation." 391 F.3d at 1200-01, 73 USPQ2d at 1145-46. The court stated that "the prior art's mere disclosure of more than one alternative does not constitute a teaching away from any of these alternatives because such disclosure does not criticize, discredit, or otherwise discourage the solution claimed..." Id. In affirming the Board's obviousness rejection, the court held that the prior art as a whole suggested the desirability of the combination of shoe sole limitations claimed, thus providing a motivation to combine, which need not be supported by a finding that the prior art suggested that the combination claimed by the applicant was the preferred, or most desirable combination over the other alternatives. Id.

Here, there is no discussion in Kingman that criticizes, discredits or otherwise discourages the solution claimed. It is the examiner's position that the prior art as a whole, that is, the combined teachings of Kingman and Meyer suggest the desirability of combining the shape and abrasive layer of Kingman with a "flexible, compressible, polymeric foam core", as taught by Meyer, for the predictable result of providing a tool that readily and completely conforms to the shape of the workpiece being processed.

Appellant further argues that the proposed modification changes the principal operation of Kingman by requiring a substantial reconstruction and redesign of one of Kingman's basic elements, its "substantially rigid body or core". The examiner strongly disagrees. The principal operation of the device of Kingman is to be a hand held scrubbing tool to remove material from a workpiece surface. Kingman, page 2, column 1, lines 9-60, outlines the use of the tool. Nowhere does Kingman contribute the

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scrubbing or scouring action to the core of the tool, but to the flexible surface of the tool, and the shape of the tool that allows it to reach surface contours. As such, to provide a core of different material, that is a flexible, compressible polymeric foam, would not be a substantial reconstruction or redesign of the core, nor would the proposed modification change the principal operation of the tool.

Appellant further argues that the rejection fails to state any rationale whatsoever for the further modification of Kingman with Hays. The examiner agrees that this statement was inadvertently omitted from the rejection. It would have been preferable that appellant had contacted the examiner on receipt of the action, so that correction could have been made. However, as appellant has chosen to make these arguments part of the appeal, the examiner has provided the motivation statement in the above rejection. If the Board considers this to be a new grounds of rejection, please remand the appeal to the examiner for further clarification. It is the examiner's position that the prior art as a whole suggests the desirability of providing the expansive and adjacent sides at the claimed angle, for the predictable result of forming an acute angle edge that would be able to scour smaller radius surfaces.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/M. Rachuba/

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Primary Examiner, Art Unit 3727

Conferees:

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